

REMARKS

This is a full and timely response to the outstanding final Office Action mailed August 4, 2008. Reconsideration and allowance of the application and pending claims are respectfully requested.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 7-12 and 15-20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kemp, et al.* ("Kemp," U.S. Pub. No. 2002/0078160) in view of *Lavery, et al.* ("Lavery," U.S. Pat. No. 6,429,947). Applicant respectfully traverses.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden 35 U.S.C. § 103 to establish obviousness by showing objective teachings in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). The key to supporting an allegation of obviousness under 35 U.S.C. § 103 is the clear articulation of the reasons why the Examiner believes that claimed invention would have been obvious. See MPEP § 2141. As stated by the Supreme Court, "[r]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR v. Teleflex*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

Applicant respectfully submits that the Examiner has not established with clearly articulated reasons that Applicant's claims are obvious in view of the prior art. Applicant discusses those claims in the following.

A. The Kemp Reference

Kemp discloses a system and method for printing over the Internet. As described by Kemp, the system includes a client 1, a service provider 2, and a portal 3. *Kemp*, paragraph 0035. The client 1 includes a computer workstation 10 that uses various application programs that can generate data to be printed. *Kemp*, paragraph 0036. The service provider 2 includes a server 20 that can receive print requests and processes print jobs. *Kemp*, paragraph 0039. The portal 3 comprises a source (e.g., the sole source) of information about a plurality of service providers, including service provider 2. *Kemp*, paragraph 0042. More specifically, the portal 3 includes a database of service provider "information" that the client 1 may access. *Kemp*, paragraph 0042.

The client 1 may submit queries to the portal 3 to locate a suitable service provider. *Kemp*, paragraph 0043. Once such a service provider is located (e.g., service provider 2), the client submits a job ticket to the service provider server 20. *Kemp*, paragraph 0053. If, after reviewing the job ticket, the service provider 2 determines that it can perform the print job described in the job ticket, the service provider replies to that effect to the client 1, at which time the client may then transmit the print job to the service provider for processing. *Kemp*, paragraph 0056.

B. Applicant's Claims

Applicant's independent claim 7 provides as follows:

7. A method of performing automated finishing in a commercial printing environment including a designer location and a print service provider location, said method comprising:

- creating at the designer location a print job to be printed by the print service provider location;

- creating a job ticket at the designer location that specifies a finishing device of the print service provider to be used to finish said print job and that contains finishing instructions;

- an automated preflight module at the designer location automatically establishing a link to the print service provider location and obtaining updated device configuration information from the print service provider location concerning the specified finishing device;

- said preflight module automatically confirming that the specified finishing device can finish said print job according to said finishing instructions of said job ticket;

- creating a production ready file at the designer location that encapsulates said print job and said job ticket;

- submitting said production ready file to the print service provider location via an electronic network; and

- generating a printed output of said print job and finishing said printed output with the specified finishing device at the print service provider location in accordance with said finishing instructions from said job ticket.

In the final Office Action, the Examiner alleged that Kemp discloses each of the above limitations with the exception of an automated preflight module, creating a production ready file at a designer location that encapsulates a print job and a job ticket,

and submitting the production ready file to a print service provider. While Applicant agrees that Kemp fails to disclose or suggest the latter limitations, Applicant respectfully disagrees with the allegation that Kemp discloses each of the other limitations of claim 1. Applicant discusses some of those limitations in the following discussion.

As a first matter, Kemp does not in fact disclose creating a job ticket at a designer location that “specifies a finishing device of the print service provider to be used to finish said print job”. In the final Office Action, the Examiner alleged that Kemp discloses creation of such a job ticket in paragraph 0069, lines 1-10. That portion of Kemp’s disclosure provides, in relevant part:

Although print driver rendering engine 14 is activated and renders the print job into NPDL and spools the data, it is not submitted to the service provider at this time. Rather, print driver 282 submits a job ticket request to service provider server 20 via Internet 5, shown as 50 in FIG. 4. That is, print driver 282 submits a job ticket that includes the user's information (including payment type), type of print job to be printed (black and white, color or photo, finishing options, etc.), and number of pages contained in the print job, to service provider server 20.

Kemp, paragraph 0069, lines 1-10. As is clear from the above excerpt, Kemp does not describe a job ticket that “specifies a finishing device of the print service provider to be used to finish said print job”. Indeed, not only does that portion of Kemp’s disclosure fail to mention anything about the finishing device that will be used to finish the print job, that portion of Kemp’s disclosure does not even mention job tickets.

Kemp also does not actually disclose a module at the designer location “obtaining updated device configuration information from the print service provider

location concerning the specified finishing device". As noted above, Kemp does not discuss the finishing devices that are used to finish print jobs. Regardless, Kemp certainly does not describe a situation in which the designer (i.e., the creator of a document who submits the document to a print service provider to be printed) obtains "updated device configuration information" about such a finishing device. Applicant further notes that paragraph 0070 of the Kemp reference, which was cited and relied upon by the Examiner, does not in fact describe updated device configuration information concerning a finishing device being provided to a designer location. That paragraph provides:

Upon receiving the job ticket and payment information 50 from print driver 282, service provider server 20 processes the job ticket to generate a job identification number and a cost of processing the job. In this regard, in processing the job ticket, service provider server 20 may determine that service provider 2 may not be able fill the requested job ticket. For instance, the user may have requested various special instructions (i.e. finishing options) that the service provider is not able to perform. In this case, service provider server 20 may determine that the job ticket can not be processed and therefore returns a message to this effect to print driver 282. If service provider server 20 determines that service provider 2 is able to fulfill the job ticket, then the server calculates a cost, and perhaps even an estimated completion date, based on the job ticket information and generates a job identification number for the job ticket. Service provider server 20 then responds to the job ticket with the cost and job ID information 51 and submits this information via Internet 5 to print driver 282.

Kemp, paragraph 0070. As can be appreciated from the above, Kemp discloses a print service provider indicating whether it can or cannot process a print job and notifying the client who submitted the print job. Not communicated to the client, however, is any updated configuration concerning a finishing job at the service provider.

As mentioned above, the Examiner admitted that Kemp does not disclose or suggest “creating a production ready file at the designer location that encapsulates said print job and said job ticket”. In addressing that shortcoming of the Kemp reference, the Examiner cited the Lavery reference, which is alleged to comprise such a disclosure. In particular, the Examiner argued that Lavery discloses the creation of such a production ready file in column 10, lines 50-61. That portion of Lavery’s disclosure provides:

FIG. 3 shows a block diagram 300 of a generalized series of steps used in creating a print order. A customer 302 contacts a web site via the computer 304. The customer inputs data on the web site according to data prompts needed to generate the customer's desired print job. The system creates a Print Ready File (PRF), as shown in element 305. The PRF 306 is shown to the customer 302 for on-screen proofing 308 of various elements comprising the product. Once the order is approved, step 310 shows the order being sent to the printer. The PRF 306 is thereafter sent to printer as a print order 312, and the manufacturing (or printing) process begins.

Lavery, column 10, lines 50-61. In the above excerpt, Lavery describes a print ready file (PRF) that is created by a “system” from “data” provided by a customer. As a first matter, Applicant notes that Lavery’s print ready file is not created “at the designer location” as

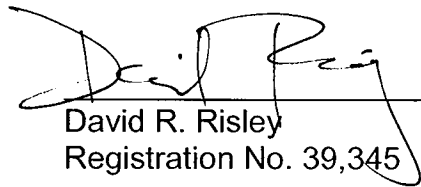
required by claim 7. Instead, it is the “system” that receives the designer’s (i.e., customer’s) data that creates the file. Furthermore, Lavery does not disclose or suggest that Lavery’s print ready file “encapsulates” both a print job and a job ticket. Instead, Lavery merely indicates that the file is created from “data,” which presumably comprises the various data that are to be printed (i.e., the print job).

In view of the foregoing, Applicant respectfully submits that the Kemp/Lavery combination does not render independent claim 7 or its dependents obvious. Applicant further submits that independent claim 15 and its dependents are likewise not rendered obvious by the Kemp/Lavery combination given that claim 15 contains limitations that are similar to those described above. Applicant therefore respectfully requests that all rejections be withdrawn.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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